

REMARKS

Claims 1-11 are pending and rejected in the application. By this Amendment, Applicants have amended Claim 1 and added claim 12. The remaining claims remain pending.

I. Rejection of claims 1-10 under 35 U.S.C. § 112

The Office Action rejected claims 1-10 under 35 U.S.C. § 112, second paragraph. More particularly, the Office Action rejected claims 1-10 because it was unclear to the Examiner if the insert is actually just the formed blank metal substrate. Claim 1 has been amended to clarify that in step (d) a second force is applied to shape the blank metal substrate in the manner recited. Step (e) has been clarified to recite that elastomeric material is supplied to select predetermined portions of the blank metal substrate. Applicants submit that in view of the amendment to claim 1, the rejection is now addressed. Nevertheless, if the Examiner still has concerns, the courtesy of a telephone discussion to jointly develop language to address the Examiner's concern is respectfully requested.

II. Rejection of claims 1-5 and 11 under 35 U.S.C. § 102(b)

Claims 1-5 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,096,228 to Decker ("Decker"). The rejection is respectfully traversed.

The Office Action asserts that Decker discloses "the claimed process as evidenced at col 2, lns 40-50; col 3, lns 4-7 and 17-18; col 4, lns 36-60; col 5, lns 7-30; and figs 1-5" (see Office Action at page 2, item 3). To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ "The identical invention must be shown in as complete detail as is contained in the ... claim."²

The rejection of claims 1-5 is respectfully traversed. Compressible element 11 of Decker is not a blank metal substrate in the manner required by the claimed invention, which

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

is explicitly distinguished in claim 1 from an elastomeric (i.e., non-rigid) material. In the final office action the Examiner suggests that because of the cross-hatching shown in the figures, element 11 is in fact a metal. Such an interpretation by the Examiner is directly in contrast to the teachings of the specification of Decker itself:

The compressible component 11 may be cut from conventional gasketing material. A wide variety of suitable gasketing materials are commercially available, including rubber and rubberlike materials, compressible asbestosboard, or fiberboard materials, cork, composites and the like. The preferred material is asbestosboard, for example such as sold by Colonial Fiber Corp., Manchester, Conn. under the designation S-601 High Temp. Also especially suitable is hard cellulose fiberboard to the faces of which is laminated a compressible gasket skin or liner, about 0.002 to 0.005 inch thick. Exemplary of this material is that sold by Colonial Fiber Corp. under the designation S-560.

Column 3, lines 17-29. The background of Decker explicitly distinguishes between a compressible component and a "rigid non-compressible component" such as the metal substrate of the claimed invention: "In the manufacture of gaskets, for example automobile carburetor gaskets, it is known to associate the compressible gasketing material with a rigid non-compressible component which provides a stop or positive limit to the compression of the gasketing component." Column 1, lines 16-20. The function of the compressible component is also discussed in the background: "The compressible component must of course be thicker than the rigid, compression-limiting component, so as to be compressed in use and thereby form a seal." Column 1, lines 45-49.

Moreover, the rigid element is also not disclosed as being metallic, but is more rigid than the compressible component 11. "The rigid component may be molded from a flowable resin which may be a thermosettable plastic. It is desirably injection molded in, or around, the compressible component." Column 1, lines 43-44.

Thus, the Examiner is wrong on two points. First, the specification of Decker explicitly precludes the compressible element 11 from being metallic since it must be able to more readily deform as compared to "incompressible component 12," which is also non-metallic. Nevertheless, even if compressible element 11 were somehow metallic, the type of

metal used must be such that it is readily compressible as compared to "incompressible component 12", (illustrated in the same figures as being non-metallic), directly in contrast to the claimed invention, which teaches the use of a metallic substrate in conjunction with an elastomeric material acting as a seal.

Dependent claim 12 has been added to more explicitly recite the relationship between the metal substrate and the elastomeric material. Decker explicitly teaches away from the relationship as noted above, by requiring that compressible component of Decker must of course be thicker than the rigid, compression-limiting component, so as to be compressed in use and thereby form a seal. Thus, if the elastomeric material is the incompressible material and the metal substrate is the compressible material, as desired by the Examiner to apply Decker, the claimed invention is contrary to this teaching.

Decker also does not teach the formation of an insert from a blank as recited explicitly in the claim. Instead, "component 11 is preformed, as by die cutting, stamping and the like." (Column 4, lines 13-14). The creation of a groove within component 11 during molding is simply to minimize flashing during molding. It has nothing to do with the overall shape and function of the component. In fact, if the groove were placed within the component before the molding operation, the flashing would not be minimized. Thus, the creation of a groove during molding is not intended to reduce the number of forming operations; and as already noted Decker explicitly requires such pre-forming operations prior to the final molding step.

Nor does Decker teach the supplying of an elastomeric material to selected predetermined portions of the insert and then curing it. Component 12 is taught as being the "rigid component" as contrasted with the "compressible component", which as noted above, is rubberlike according to the specification of Decker. Thus, an elastomeric material is not molded as required by claim 1.

In contrast, the claimed invention reduces the number of forming operations required to make a final product by combining a metal forming process with a molding process such that a blank metal substrate is shaped into a final insert while an elastomeric material is supplied and then cured into its final shape.

For each of these reasons, claims 1 and 11 are patentable over the prior art of record.

While claims 2-5 are patentable since claim 1 is patentable, they are also independently patentable. For example, claim 3 recites that the insert comprises a metallic body and includes an elastomeric sealing bead bonded to said body, wherein said body is plastically deformed via said application of said second force to shape said insert. Decker teaches away from the insert comprising a metallic body as well as an elastomeric sealing bead bonded to the body. Claim 4 explicitly requires that the insert be manufactured in a single mode process that includes the shaping of the insert body and the molding of the bead. Decker teaches the use of multiple processes and not a single mode process.

III. Rejection of claims 6-10 under 35 U.S.C. §103(a)

Claims 6 -10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Decker. The rejection is respectfully traversed.

The Office Action acknowledges that Decker does not teach "*using an insert having radially extending arms; using an insert having arms wherein at least one of the arms has an offset elbow; using an elbow that provides a connection between the arm and a shoulder portion of the insert wherein the shoulder portion is contiguous with the peripheral edge of the closed loop of the insert*" (see Office Action at page 3 lines 9 – 13). Thus, the Examiner simply asserts that it a mere matter of design choice. Such an assertion is inappropriate. The Examiner may not merely state that a specific feature is a design choice but must provide reasoning as to why the feature is a design choice. *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). Moreover, the statement that the "claimed design is well-known in the gasket art" is completely wrong.

Nowhere in the prior art of record is there a teaching of the limitations of claims 1-5 as discussed above. Moreover, even if Decker were somehow applicable, at most it teaches the formation of a simple groove. The ability to create a metal insert while molding an elastomeric material that has a sealing body portion defining a closed loop and further comprising radially extending arms is an explicit recitation of the complexity of the die operation taking place within the mold. It is completely contrary to anything known in the art. It is the operation that is being claimed and not the finished product. Thus, the

Examiner's reliance of the indicated patents (i.e., 6,562,573, 3,619,458, and 5,618,050) is misplaced.

The same comments are applicable to claims 7-9, wherein each of the dependent claims includes a further level of complexity as to the shape of the final insert and elastomeric material that is cured. Thus, claims 6-10 are patentable over the prior art of record independently of the fact that they are dependent on claim 1.

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1187 from which the undersigned is authorized to draw.

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Respectfully submitted,

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